



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,281	07/23/2001	Douglas Paul Allard	11533.0012.CPUS04	7768

7590 04/14/2004

HOWREY SIMON ARNOLD & WHITE, LLP
750 Bering Drive
Houston, TX 77057

EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
----------	--------------

3671

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,281

Applicant(s)

ALLARD ET AL.

Examiner

Alexandra K Pechhold

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,10-14,27 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 2, 6, 10, 11, 14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by “Enviropod” (NZ 299114).**

Enviropod discloses an apparatus and a catch basin filtration system comprising:

(a) a filter body seen as filtration means (2) in Fig. 1,

(b) a filter body support seen as cage means (3) in Fig. 1, dimensioned and adapted to cooperatively engage with the inlet and filtration means (2) to substantially maintain the filtration means (2) in a pre-selected position within the inlet,

(c) an initial high flow bypass, seen as outlet (14) in Fig. 1, situated within the cage means (3) and capable of deflecting the passage of excess fluid during periods of high volume fluid flow, and

(d) a secondary high flow bypass, seen as overflow opening (13) in Fig. 1, situated within the filter body support and capable of passing excess fluid during periods of high volume fluid flow, and the overflow opening (13) being separate and distinct from the outlet (14).

Regarding claim 2, Enviropod discloses that when inflow exceeds outflow, the water level in the bag slowly rises until flow bypasses the filter through the overflow (page 11, lines

Art Unit: 3671

10-11). Therefore, fluid will flow through outlet (14) before it overflow through the overflow opening (13).

Regarding claim 6, the outlet (14) of Enviropod can be placed in an desired position, thereby being adjustable. Furthermore, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

Regarding claims 10, 11, and 14, Enviropod discloses that the filtration means (2) is made from a geotextile material or nylon or shade cloth, suitable for the filtration of suspended solids from water passing through the material (page 8, lines 6-7). Inherently, the geotextile material or nylon or shade cloth of the filtration means may become displaced as water is filtered therethrough.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3671

4. **Claims 1, 2, 6, 10-12, 14, and 27 are also rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al (US 6,093,314).**

Wilson discloses an apparatus and a catch basin filtration system comprising:

- (a) a filter body seen as filter (44) in Figs. 1 and 2,
- (b) a filter body support seen as outer housing (12) and inner sleeve (32) in Figs. 1 and 2, dimensioned and adapted to cooperatively engage with the inlet and filter (44) to substantially maintain the filter (44) in a pre-selected position within the inlet,
- (c) an initial high flow bypass, seen as outlets (30) in Figs. 1 and 2, situated within the outer housing (12) and capable of deflecting the passage of excess fluid during periods of high volume fluid flow, and
- (d) a secondary high flow bypass, seen as grating (57) in Fig. 3, situated within the filter body support and capable of passing excess fluid during periods of high volume fluid flow, and the grating (57) being separate and distinct from the outlets (30).

Regarding claim 2, excess water will not flow out of the grate (57) before it flows through outlets (30).

Regarding claim 6, the outlets (30) of Wilson can be placed in an desired position, thereby being adjustable. Furthermore, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

Regarding claims 10 and 14, Wilson discloses one absorbent container within the filter body, seen as filter (44) which is formed of a geotextile fabric capable of absorbing petroleum-based products such as gasoline, oil, grease and the like (Col 5, lines 45-50).

Art Unit: 3671

Regarding claim 11, the filter (44) of Wilson is supported by a pair of hooks (46) (see Fig. 4) on one side only, therefore capable of being displaced.

Regarding claim 12, Wilson discloses that one type of filter suitable for use as filter (44) is sold under the name and mark StreamGuard™ by Foss Environmental & Infrastructure of Seattle, Wash (Col 5, lines 47-50). The contents of StreamGuard™ as disclosed in the attached product description

(<http://www.epa.gov/region1/steward/ceitts/stormwater/techs/streamguardskimmer.html>)

comprises 3 pounds of hydrocarbon-absorbing polymer contained in a screen pillow, the oleophilic StreamGuard™ polymer media designed not deteriorate or release absorbed hydrocarbons.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US 6,093,314).** The single filter (44) of Wilson can be viewed as an elongated boom. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more than one boom, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

7. Claims 3-5 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 3/17/04 have been fully considered but they are not persuasive.

Rejection using New Zealand Patent Publication No. 299114:

Applicant first argues that Enviropod fails to include “a filter body support dimensioned and adapted to cooperatively engage with said inlet and with said filter body to substantially maintain said filter body in a pre-selected position within said inlet,” as recited in applicant's claims 1 and 27. As noted, the Examiner views the “filter body support” equivalent to Enviropod's cage means (3), which is dimensioned and adapted to cooperatively engage with said inlet and with the filtration means (2) to substantially maintain said the filtration means (2) in a pre-selected position within said inlet. The applicant disagrees with the Examiner's view on this. True, the cage means (3) is attached to a separate frame structure. But the filtrations means (2) is shown suspended inside the cage means (3), and can be thereby viewed as “adapted to cooperatively engage ... with said filter body....”. The presence of the support means (4) in Enviropod is irrelevant to this argument, since all here at issue is the “cooperative engagement” between the cage means (3) and filtration means (2). The act of being “cooperatively engaged”

involves: “to cause (mechanical parts) to mesh” or “to come together and interlock (as of machinery parts)”. Merriam Webster’s Collegiate Dictionary (10th Ed.) Here in Enviropod, the filtration means (2) is meshed with the cage means (3) since it rests inside it, or one could easily view the two structures as “coming together” due to their proximate, intercooperative nature as used in the filter device.

Applicant’s second argument pertaining to Enviropod is that Enviropod does not disclose “... an initial high flow bypass situated within said filter body support and capable of deflecting the passage of excess fluid during periods of high volume fluid flow...”. Applicant cites support from the Dictionary definition of “bypass”, as a “passage to one side; esp. a deflected route usu, around a town.” Applicant’s argument is contradictory, since applicant and Examiner agree that that in Enviropod the water will first, initially flow out of the outlet (14) when the water level rises; but then applicant states that the outlet (14) therefore does not deflect (or cause to turn aside) the passage of excess fluid from normal flow during periods of high flow. To the contrary, the flow through the outlet (14) can be considered a “bypass” since it occurs through a “passage to one side” of the filter device (1), and thereby deflects fluid to the side of the device. More specifically, the outlet (14) deflects *excess* fluid, since excess fluid can be viewed as fluid accumulating in the filter device at a level above the bottom of the outlet (14). When the water accumulates to a depth where it reaches the level of the outlet (14), this level of water can be viewed as *excess* in the broadest interpretation of applicant’s claim language.

Art Unit: 3671

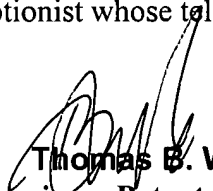
Rejection using US Patent No. 6,093,314:

Applicant makes a similar argument in Wilson, that the outlet openings (30) in Wilson do not constitute an initial high flow bypass situated within the filter body support that is capable of deflecting the passage of excess fluid during periods of high volume fluid flow, as applicant recites in amended claims 1 and 27. Again, applicant notes that the outlet openings (30) serve as a first or primary means for releasing water in the drain insert. While this is certainly true, the Examiner maintains the argument that the outlet openings (30) of Wilson can be considered a "bypass" since each one occurs as a "passage to one side" of the drain insert, and are capable of deflecting the passage of excess fluid during periods of high volume fluid flow. *Excess fluid* is therefore viewed as a fluid level at the height of the outlets (30), causing the fluid to spill out of the outlet (30).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.



Thomas B. Will
Supervisory Patent Examiner
Group 3600

AKP
4/5/04